

## REMARKS

At the time the present Office Action issued, claims 1 to 20 were pending.

All claims stand rejected. However, claims 4, 10, and 13 have been objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form. Examiner is respectfully thanked for his consideration and for having diligently identified allowable subject matter (see Numbered paragraph 8 of the Office Action).

The present amendment amends claims 1, 4, 9-15, and 20; cancels claims 8 and 16-18; and adds new dependent claims 21 to 29. The amendments and cancellations are made without prejudice and under express reservation of Applicant's right to pursue corresponding subject matter in a divisional or continuation application. It is formally made of record that Applicant respectfully traverses every rejection made, notwithstanding the present amendments and cancellations.

### Rewriting of claims 4, 10, and 13 in independent form

From Numbered paragraph 8 of the Office Action it follows that the Examiner intends to allow claims 4, 10, and 13, provided that they are rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 4 has been rewritten in independent form, by replacing the reference to claim 1 with the full subject matter of original claim 1. This amendment does not narrow or limit the claim since the subject matter was already part of the claim by virtue of reference to claim 1. The amendment fully complies with the rewriting instructions provided for in Numbered paragraph 8 of the Office Action, and hence claim 4 is expected to be in allowable form.

In addition, also in claim 4, the phrase "using a closure element" has been added in order to provide formal antecedent basis for the term "the closure element". This does also not constitute a limitation, since "the closure element" already formed part of claim 4.

Claims 10 and 13 have both been written in independent form, by including subject matter from original claim 8. The amendments do not narrow the claims concerned. In fact, the amended claims 10 and 13 are broader, because the subject matter from the intervening claim 9 ("wherein the closure element comprises a surface retrievable part"), and the feature "which part has a largest diameter of at least 5 cm" from original claim 8, have not been included in claims 10 and 13.

Notwithstanding, it is believed that claims 10 and 13 still present allowable subject matter. Claims 8 and 9, which formed the base- and intervening claim of each of claims 10 and 13, were rejected over WIPO '488 (Runia) in view of Schuh and further in view of Estes.

The Examiner considered a passage to allow a tool with a diameter of at least 5 cm to be taught by Estes (see Office Action, line 5 of Numbered paragraph 6). And, Examiner considered the subject matter from intervening claim 9 to be taught by the primary reference WIPO '488 (see lines 14-16 of Numbered paragraph 5 in the Office Action).

Since Examiner considered the features “which part has a largest diameter of at least 5 cm” and “wherein the closure element comprises a surface retrievable part” to be taught by the prior art, Attorney for Applicant assumes that the Examiner did not rely on these features when deciding to hold claims 10 and 13 to contain allowable subject matter. Therefore, Attorney for Applicant respectfully submits that not including these feature in the claims will, in all likelihood, not affect Examiner’s opinion about the allowability of claims 10 and 13.

As a final remark, Examiner’s attention is respectfully drawn to new claims 23 to 26 which, in combination with claim 9, contain the features that have not been incorporated in the rewritten claims 10 and 13. It is respectfully submitted that none of the amendments constitute an addition of matter.

#### Other amendments

Claim 1 has been amended by inclusion of subject matter from now cancelled claims 17 and 18.

Prior reference to claim 8 in claims 11, 12, and 14 has been changed to a reference to claim 13, which now expressly includes the relevant antecedent basis for the subject matter of claims 11, 12, and 14.

Claim 15 has been amended by including the full subject matter of previously presented claims 17 and 18, and by deleting the phrase “which part has a largest diameter of at least 5 cm.” Corresponding subject matter has now been captured in new dependent claim 21.

Prior reference to claim 15 in previously presented claim 20 has been changed to a reference to claim 21, because new claim 21 does - and claim 15 no longer does - provide antecedent basis for the subject matter of claim 20.

New claim 22 is based on original claim 14.

New claim 27 recites subject matter from previously presented claim 17, actively voiced.

New claim 28 recites subject matter from original claim 10 actively voiced.

New claim 29 is supported by page 17 of the specification, lines 22-25.

It is respectfully submitted that the amendments do not constitute addition of subject matter.

#### Claim rejections under 35 USC § 112

In Numbered paragraphs 1 and 2 of the Office Action, claim 4 has been rejected under 35 USC § 112, second paragraph, because the Examiner has found insufficient antecedent basis for the term “the closure element”.

This rejection has been overcome by adding to claim 4 the term “using a closure element,” which provides the requested antecedent basis.

#### Claim rejections under 35 USC § 103

##### Claims 15 - 18

In Numbered paragraphs 3 and 4, claims 15, 17, and 18 have been rejected under 35 USC § 103(a) as being unpatentable over Harrell *et al* '023 in view of Estes.

The Office Action states that Figure 5 of Harrell discloses a bottom hole assembly attachable to a tubular drill string. The bottom hole assembly has a drill bit (54), a drill steering system (60), and a surveying system (62). The bottom hole assembly is provided with a longitudinal internal passage for at least part of an auxiliary tool, such as a production tubing. The Office Action continues by stating that the drill steering system is provided in the form of a mud motor comprising a tubular stator and a rotor arranged in the tubular stator, and that there is a bit shaft, which is arranged to be driven by the rotor and suitable for transmittal of torque to a drill bit. It is then stated that the rotor is releasably connected to the bit shaft, and that after it is removed from the hole, after disconnection from the bit shaft, the rotor is capable of being longitudinally removed from the stator.

Attorney respectfully traverses the rejection in so far as concerned its applicability to amended claim 15. The Examiner has failed to establish a *prima facie* case of obviousness because the prior art does not teach or suggest all the claim limitations.

MPEP 2143.03 states:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

The Examiner has failed to consider every claim limitation, in particular the claim limitation “whereby the interior of the stator forms part of the longitudinal internal passage” that appeared in claim 18. Claim 18 is now cancelled, but the relevant subject matter now forms part of claim 15.

Harrell discloses in Col. 9 lines 50-52 (emphasis added):

The rotor/stator assembly 60 and the drive shaft 90 are retrievable from the completion assembly 30.

And in Col. 10 lines 1-3 (emphasis added):

Then, the operator can retrieve the work string 20 along with the rotor/stator assembly 60,...

Hence, Harrell teaches the rotor/stator to be retrievable as an assembly only. Thus, Harrell fails to teach or suggest the interior of the stator to form part of the longitudinal internal passage.

Estes does not remedy Harrell's lack of disclosure, because Estes does not disclose a rotor/stator assembly at all.

Reconsideration and, ultimately, withdrawal of the rejection is therefore respectfully requested.

#### Claims 1-3, 5 and 6

In Numbered paragraph 5 of the Office Action, claims 1-3, 5 and 6 have been rejected under 35 USC § 103(a) as being unpatentable over the WIPO document '488 to Runia in view of Schuh.

Each of the claims rejected in this paragraph of the Office Action ultimately depends on claim 1. Claim 1 has been amended to include features relating to the drill steering system being provided in the form of a mud motor and its structural relationship with the passageway.

Attorney respectfully traverses the rejection of Claim 1, and of Claims 2, 3, 5 and 6 each ultimately depending on claim 1, in its applicability to claim 1 in its amended form.

The cited prior art, WIPO '488 in view of Schuh, does not teach a drill steering system provided in the form of a mud motor. Neither, therefore, does the combination of WIPO '488 and Schuh disclose any of claimed features of the mud motor, its connection to the bit shaft, nor its relation to the passageway.

Therefore, at least for failing to teach or suggest all the claim limitations of amended claim 1, no *prima facie* case of obviousness of claim 1 can be established based on the cited combination of references.

Of the prior art applied anywhere in the Office Action against any of the claims, Harrell '023 is the only document that discloses a downhole drilling motor. However, Harrell does not teach or suggest the interior of the stator to form part of the longitudinal internal passageway for passing an auxiliary tool through (further explanation has already been provided hereinabove).

Since amended claim 1 contains features that are not taught or suggested by any of the prior art applied to the claims, the Examiner has not established a *prima facie* case of obviousness against claim 1 in its amended form.

Reconsideration is respectfully requested, and, ultimately withdrawal of the rejection. The same requests are made in respect of Claims 2, 3, 5 and 7, each being ultimately dependent on Claim 1.

Claims 7-9, 11, 14, 15, 19 and 20

In Numbered paragraph 6, Claims 7-9, 11, 14, and 15 have been rejected under 35 USC § 103(a) as being unpatentable over WIPO '488 to Runia in view of Schuh and further in view of Estes.

Claim 7 depends on claim 1. It has been shown above that claim 1, and - by virtue of its reference to claim 1 - also claim 7, contains features that are not taught or suggested by any of the prior art applied to the claims. This explains why no *prima facie* case of obviousness has been established in respect of claim 7.

The rejection of claim 8 has become moot in view of cancellation.

The rejection of claim 9 has become moot, because it now depends on claim 10, which according to paragraph 8 of the Office Action, contains patentable subject matter. Likewise, the rejections of claims 11 and 14 have become moot, because they now depend on claim 13.

The remaining claims, 15, 19 and 20 all depend on claim 15.

Attorney for Applicant respectfully traverses the rejection of claim 15 and its dependent claims 15. No *prima facie* case of obviousness has been established against claim 15 in its amended form, for failure of the cited references to teach or suggest all the limitations of the claim.

It is respectfully submitted that the cited prior art, WIPO '488 in view of Schuh, does not teach a drill steering system provided in the form of a mud motor. Neither, therefore, does the combination of WIPO '488 and Schuh disclose any of the particulars of the mud motor, its connection to the bit shaft, or its relation to the passageway as presently claimed.

Therefore, reconsideration, and withdrawal of the rejections made in Numbered paragraph 6 of the Office Action.

Claim 12

In Numbered paragraph 7, Claim 12 has been rejected under 35 USC § 103(a) as being unpatentable over WIPO '488 in view of Schuh and Estes as applied to Claim 8, and further in view of Comeau (US 6,340,063).

This rejection has become moot, because claim 12 has been made dependent on claim 13 whereas claim 13 was considered to present allowable subject matter (see Numbered paragraph 8 of the Office Action).


Concluding remarks

In conclusion, Attorney has addressed each and every ground for objection and rejection raised by the Examiner in the Office Action. In particular, it has been demonstrated that still no *prima facie* case of obviousness has been established against any of the independent claims.

Attorney respectfully submits that the specification and claims, whether original, previously presented, or new, are in a state ready for allowance. In the event the Examiner has any questions or issues regarding the present application, the Examiner is invited to call the undersigned prior to the issuance of any written action.

Respectfully submitted,

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